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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVIS-DANG HOANG NHAN, MARK M. MLEZIVA,
LAWRENCE H. SAWYER, PEIGUANG ZHOU

Appeal 2009-007494
Application 10/699,193
Technology Center 3700

Decided: June 25, 2010

Before: JENNIFER D. BAHR, STEVEN D.A. McCARTHY, and STEFAN
STAICOVICI, *Administrative Patent Judges.*

BAHR, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Davis-Dang Hoang Nhan et al. (Appellants) appeal under 35 U.S.C. § 134 (2002) from the Examiner's decision rejecting claims 1-14, 17-21, and 114. Claims 15, 16, and 22-29 have been withdrawn. Claims 30-113 have been canceled. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

The Invention

Appellants' claimed invention is directed to an absorbent article having an absorbent composite secured to a stretchable substrate of the article. Spec., para. 1.

Claim 1, reproduced below, is illustrative of the claimed invention.

1. An absorbent article comprising:
a stretchable substrate; and
an absorbent composite comprising a layer of adhesive composition in contact with the stretchable substrate and a layer of particulate superabsorbent material applied to and held by the adhesive composition, the absorbent composite being secured to the substrate by the adhesive composition, the absorbent article being stretchable, the layer of particulate superabsorbent material remaining secured to the substrate by said adhesive upon stretching of the absorbent article.

The Rejections

Appellants seek review of the Examiner's rejection under 35 U.S.C. § 102(b) of claims 1-4 and 17-21 as anticipated by U.S. Patent 5,496,429 to Hasse (issued Mar. 5, 1996). Appellants do not seek review of the

Examiner's rejection under 35 U.S.C. § 103(a) of claims 5-14 and 114 as unpatentable over Hasse in view of Jiang (US 2004/0127614 A1, published Jul. 1, 2004, filed Oct. 15, 2002 and Apr. 4, 2003)¹, which we summarily sustain.

SUMMARY OF DECISION

We AFFIRM-IN-PART.

OPINION

Contentions

Claim 1 requires an absorbent article with a stretchable substrate. Appellants argue that the Examiner's rejection of independent claim 1 fails to demonstrate that Hasse describes a stretchable substrate. Appeal Br. 4-5; Reply Br. 1-3. The Examiner finds that Hasse describes a flexible substrate, thermoplastic polyethylene backsheet 26 (Ans. 3-4), and that this material is an elastomer and thus stretchable (Ans. 6-7). Appellants respond that not all polyethylene is stretchable. Appeal Br. 4; Reply Br. 2-3.

Issue

The dispositive issue presented in this appeal is whether the Examiner has discharged the initial burden of providing a basis in fact and/or technical

¹ Appellants submitted a Declaration under Rule 131 on Sep. 15, 2006 in an attempt to antedate Jiang, which claims priority from 60/418,482 and 60/460,714. Appellants did not attempt to antedate the disclosure of 60/418,482. *See* Final Rejection mailed Nov. 21, 2006, p. 2 (noting the Examiner's discussion of Jiang remaining valid prior art); Non Final Rejection mailed Oct. 2, 2007, p. 4 (requesting Appellants address all outstanding rejections).

reasoning to support the finding that, based on Hasse's teachings, Hasse's thermoplastic polyethylene is necessarily stretchable.

Principles of Law

An Examiner's finding of inherency cannot be based on likelihood. *See In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981) (*quoting Hansgirk v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939)) ("Inherency . . . may not be established by probabilities or possibilities."); *Cont'l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991) (when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill). When relying on the theory of inherency, the examiner has the initial burden of providing a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic reasonably flows from the teachings of the applied prior art. *See In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986).

Findings of Fact

The backsheet 26 in Hasse is "a woven or non-woven material, polymeric films such as thermoplastic films of polyethylene or polypropylene, or composite materials." Hasse, col. 20, ll. 56-60.

A dictionary definition of "polyethylene" is "[a] hard-to-soft, ductile, easily molded thermoplastic" and "polypropylene" is "a synthetic, crystalline, thermoplastic polymer." *Academic Press Dictionary of Sci. and Tech.* (1992) (retrieved from <http://www.credoreference.com/entry/apdst/>) (last retrieved Jun. 7, 2010).

Appellants' Specification defines the term "stretchable" as referring to a material "that may be extensible and/or elastic. That is, the material may be extended, deformed or the like, without breaking, and may or may not significantly retract after removal of an extending force." Spec., para. 56. The Specification defines the terms "elastic" and "elastomeric" as being elongatable in at least one direction upon application of an elongating force and retracting to dimensions close to its original dimensions upon removal of the elongating force. *Id.*

Analysis

The Examiner first finds that Hasse's backsheet 26 is stretchable because it is flexible and conforms to the general shape and contours of a body. Ans. 6. However, conformance to a shape does not necessarily imply an ability to "draw out or extend,"² or to be extended, deformed, or elongated. Thus, a thin sheet of plastic could bend to conform to a body, but bending does not necessarily require stretching as defined in the Specification.

The Examiner next finds that "thermoplastic polyethylene or polypropylene is by its nature an elastomer, and is stretchable." Ans. 7 (emphasis omitted). In particular, the Examiner attempts to distinguish a "simple" polyethylene or polypropylene material from a "thermoplastic" polyethylene or polypropylene material. Ans. 6-7. However, all polyethylene and polypropylene materials are thermoplastic. "Thermoplastic" merely means "(of a material, especially a synthetic plastic

² An ordinary meaning of "stretch" is "to draw out or extend...." *Collins English Dictionary* (2000) (retrieved from <http://www.credoreference.com/entry/hcengdict/stretch>) (last retrieved Jun. 7, 2010).

or resin) becoming soft when heated and rehardening on cooling without appreciable change of properties. Compare thermosetting." *Collins English Dictionary*. The term "thermoplastic" is not synonymous with the term "elastomeric," as the Examiner's reasoning implies, and does not necessarily indicate stretchability. Hence, the Examiner's reliance on Hasse's description of "thermoplastic" polyethylene or polypropylene materials to establish inherent stretchability is unavailing. Perhaps most significantly, the Examiner acknowledges that at least some polyethylene and polypropylene materials are not elastomeric and are not stretchable. Ans. 6-7. Therefore, the Examiner has not shown that Hasse's thermoplastic polyethylene and polypropylene backsheet 26 is necessarily stretchable.

Conclusion

Because the Examiner has not established that all thermoplastic polypropylene or polyethylene materials are stretchable, the Examiner's finding that the backsheet in Hasse necessarily is a stretchable substrate as recited in claim 1 is not based on fact or technical reasoning. The Examiner's rejection of dependent claims 2-4 and 17-21 relies on the same unsupported theory of inherency.

DECISION

We reverse the Examiner's decision as to claims 1-4 and 17-21. We affirm the Examiner's decision as to claims 5-14 and 114.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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